

**REMARKS**

Claims 44, 45, 51-54, 56, 58-60 and 66-68 remain in the application. Reconsideration of the application in view of the amendments and the remarks to follow is requested.

Submitted herewith are substitute drawings, red-lined drawings, and a substitute drawing request form addressed to the Drafting Branch of the PTO. Applicant asks that the Examiner forward the substitute drawing request to the Drafting Branch. The substitute drawings cure several errors in the originally submitted drawings. Specifically, the substitute drawings provide a label "12" at a substrate region. Such amendment to the drawings brings the drawings into conformance with the specification which, for example, at p. 5, ln. 16, indicates that a substrate region is labeled as "12". The amendments to the drawing remove an extraneous reference character from Fig. 7. Also, the drawings amend Fig. 10 to change the location of an upper surface of plugging material 44. Such amendment brings Fig. 10 into conformance with Fig. 11 which shows an upper surface of plugging material 44 substantially coextensive with an upper surface of a fin 32.

Claims 44, 45, 51-54, 56, 58-60, 66 and 67 (and presumably 68 as well) stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter that is not enabled by the specification, and also stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

1 The Examiner states (p. 6) that "The PTO is not bound by any  
2 principle of "stare decisis," for example, which would require mindlessly  
3 following previously incorrect conclusions." The Examiner is mistaken.

4 The PTO and the Examiner are bound by the principles of stare  
5 decisis and are required to follow legal decisions made by the courts.  
6 These decisions are organized and provided for use by Examiners in the  
7 MPEP.

8 Standards for determining enablement are provided, for example,  
9 in MPEP §2164.08, entitled "Enablement Commensurate in Scope With  
10 the Claims." This MPEP section sets forth criteria for determination  
11 of enablement, and states that "As concerns the breadth of a claim  
12 relevant to enablement, the only relevant concern should be whether the  
13 scope of enablement provided to one skilled in the art by the disclosure  
14 is commensurate with the scope of protection sought by the claims."  
15 *In re Moore*, 439 F.2d, 1232, 1236, 169 USPQ 236, 239 (CCPA 1971).

16 A two step test is set forth in this MPEP section for  
17 determination of enablement. The first step is to determine how broad  
18 the claim is with respect to the disclosure. The breadth of the claims  
19 is clear with respect to the disclosure.

20 The second step is to determine if one skilled in the art is  
21 enabled to make and use the entire scope of the claimed invention  
22 without undue experimentation. The Examiner has failed to show that  
23

1 one skilled in the art is not enabled to make and use the entire scope  
2 of the claimed invention without undue experimentation.

3 This MPEP section further states that "Nevertheless, not everything  
4 necessary to practice the invention need be disclosed. In fact, what is  
5 well-known is best omitted. All that is necessary is that one skilled  
6 in the art be able to practice the claimed invention, given the level of  
7 knowledge and skill in the art. Further the scope of enablement must  
8 only bear a "reasonable correlation" to the scope of protection sought  
9 by the claims."

10 In the present case, the process by which a feature size is  
11 determined is irrelevant. What is relevant is a technique for fabricating  
12 capacitors whereby some aspects of the capacitors are smaller than a  
13 size of lithographic features forming the capacitors and other elements  
14 of the circuit. "The statutory requirement of particularity and  
15 distinctness in claims is met only when they clearly distinguish what is  
16 claimed from what went before in the art and clearly circumscribe what  
17 is foreclosed from future enterprise." *Union Carbon Co. v. Binney &*  
18 *Smith Co.*, 317 U.S. 228, 236, 55 USPQ 381, 385 (1942). The pending  
19 claims meet these requirements.

20 A decision on whether a claim is invalid under this provision  
21 requires a determination of whether those skilled in the art could  
22 understand what is claimed when the claim is read in light of the  
23 specifications. *Seattle Box Co. v. Industrial Crating & Packing*, 731 F.2d

1 818, 826, 221 USPQ at 573. If the claims, read in light of the  
2 specifications, reasonably apprise those skilled in the art both of the  
3 utilization and scope of the invention, and if the language is as precise  
4 as the subject matter permits, the courts can demand no more.  
5 *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624,  
6 221 USPQ 568, 573-74 (Fed. Cir. 1985). The statistics on usage of  
7 language in issued patents that were previously provided show how  
8 language is used in the relevant arts, and show that the language of the  
9 claims reasonably apprises those skilled in the art of the utilization and  
10 scope of the claimed invention.

11 An example of relevant material as set forth by the courts is  
12 found in MPEP §2173.05(b), entitled "Relative Terminology" and stating  
13 that "Acceptability of the claim language depends on whether one of  
14 ordinary skill in the art would understand what is claimed, in light of  
15 the specification." This MPEP section additionally states that "When  
16 relative terms are used in claims wherein the improvement over the  
17 prior art rests entirely upon size or weight of an element in  
18 combination with other elements, the adequacy of the disclosure of a  
19 standard is of greater criticality."

20 The claims presently pending define capacitor constructions in  
21 terms of language that is well known and widely used in the relevant  
22 arts. The techniques developed by Applicants are described with  
23 sufficient clarity that any person of ordinary skill in the art is enabled

1 to practice the present invention, irrespective of the lithographic  
2 technique that is employed. Further, the terms with which the invention  
3 is described and claimed are definite. For at least these reasons, the  
4 rejections under 35 U.S.C. §112 should be withdrawn, and claims 44, 45,  
5 51-54, 56, 58-60 and 66-68 should be allowed.

6 The Examiner also states (p. 6) that "use of trademark  
7 terminology, such as "Teflon," is forbidden in claim language ...."  
8 Again, the Examiner is mistaken, and is referred, for example, to  
9 MPEP §2173.05(u), entitled "Trademarks or Trade Names in a Claim",  
10 which states conditions under which trademarks and trade names are  
11 permitted in claims.

12 Claim 44 stands rejected under 35 U.S.C. §103(a) as being  
13 unpatentable over Morihara et al. in view of Wolf et al.  
14 Claims 44, 45, 51-54, 56, 58-60, 66 and 67 (and presumably 68 as well)  
15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lee,  
16 U.S. Patent No. 5,684,316 in view of Morihara et al. and Wolf et al.

17 Claim 44 recites "each lower plate including a polysilicon plug  
18 having a diameter less than the minimum photolithographic feature  
19 dimension" which is not taught, disclosed, suggested or motivated by the  
20 cited references, alone or in any proper combination.

21 Simply stating a conclusion that "it would have been obvious" to  
22 combine teachings from references does not meet the standards for a  
23 rejection under 35 U.S.C. §103(a) as set forth in The Manual of Patent

1 Examination Procedure at §706.02(j) entitled "Contents of a 35 U.S.C.  
2 103 Rejection." This MPEP section states that three basic criteria must  
3 be met in order to establish a prima facie case of obviousness.

4 The first of these is that there must be some suggestion or  
5 motivation, either in the references themselves or in the knowledge  
6 generally available to one of ordinary skill in the art to modify the  
7 reference or to combine reference teachings. The Office Action fails  
8 to show that the subject matter of claim 44 is suggested or motivated  
9 by the teachings of the references.

10 The second requirement of MPEP §706.02(j) is that there must be  
11 a reasonable expectation of success. The third requirement is that the  
12 prior art reference (or references when combined) must teach or suggest  
13 all of the claim limitations.

14 Since all of the cited references are silent with respect to any  
15 polysilicon plug having a diameter less than the minimum  
16 photolithographic feature dimension, combining their teachings cannot  
17 possibly provide the invention as recited in claim 44.

18 Further, because the references are silent with respect to  
19 polysilicon plugs having a diameter less than the minimum  
20 photolithographic feature dimension, there can be no reasonable  
21 expectation of success in arriving at the claimed subject matter from  
22 combining their teachings. For at least these reasons, the rejection of  
23 claim 44 should be withdrawn, and claim 44 should be allowed.

1 Claim 45 recites "the adjacent stacked capacitors respectively  
2 including a lower plate having a minimum lateral spacing from one  
3 another which is less than the minimum photolithographic feature  
4 dimension wherein each of the pair of capacitors comprises: a polysilicon  
5 plug having a diameter less than the minimum photolithographic feature  
6 dimension; and in cross-section, at least two laterally opposed fins  
7 interconnected with and projecting laterally from the plug", which is not  
8 taught, disclosed, suggested or motivated by the cited references, alone  
9 or in any proper combination. As noted above, the prior art reference  
10 (or references when combined) must teach or suggest all of the claim  
11 limitations. The proposed combination fails to teach or suggest all of  
12 the claim limitations. For at least these reasons, the rejection of claim  
13 45 should be withdrawn, and claim 45 should be allowed.

14 Claim 54 recites "the adjacent stacked capacitors respectively  
15 including a lower plate having a minimum lateral spacing from one  
16 another which is less than the minimum photolithographic feature  
17 dimension, each lower plate comprising a polysilicon plug having a  
18 diameter that is less than the minimum photolithographic feature  
19 dimension and, in cross-section, at least two laterally opposed fins  
20 interconnected with and projecting laterally from the plug", which is not  
21 taught, disclosed, suggested or motivated by the cited references. For  
22 at least these reasons, the rejection of claim 54 should be withdrawn,  
23 and claim 54 should be allowed.

1 Claim 62 recites that "each finned lower plate comprises: a  
2 polysilicon plug; and in cross-section, at least two laterally opposed fins  
3 interconnected with and projecting laterally from the plug, the plug  
4 having a minimum width which is less than the minimum  
5 photolithographic feature dimension", which is not taught, disclosed,  
6 suggested or motivated by the cited references. For at least these  
7 reasons, the rejection of claim 62 should be withdrawn, and claim 62  
8 should be allowed.

9 Dependent claims 51-53, 56, 58-60 and 66-68 are allowable as  
10 depending from an allowable base claims and for their own recited  
11 features which are neither shown nor suggested by the prior art.

12 In view of the foregoing, allowance of claims 44, 45, 51-54, 56,  
13 58-60 and 66-68 is requested. The Examiner is requested to phone the  
14 undersigned in the event that the next Office Action is one other than  
15 a Notice of Allowance. The undersigned is available for telephone  
16 consultation at any time during normal business hours (Pacific Time  
17 Zone).

18  
19 Respectfully submitted,

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21 Dated: June 12, 2000

By: \_\_\_\_\_

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